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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,515	09/30/2003	Jacqueline Evynne Breuninger Buskop	1207.01A	6098

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BUSKOP LAW GROUP, P.C.  
1776 YORKTOWN  
SUITE 550  
HOUSTON, TX 77056

EXAMINER
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REESE, DAVID C

ART UNIT	PAPER NUMBER
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3677

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/675,515

Applicant(s)

BUSKOP, JACQUELINE EVYNNE  
BREUNINGER

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-10, and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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### DETAILED ACTION

In view of the appeal brief filed on 11/30/2006, and newly found art, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



- Claims 1-2, 4-10, and 12-14 are pending.

### *Claim Objections*

[1] Regarding claim 9, the phrase "and like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "like soft candies"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d). In the instant case, consider removing the term "like" from the claim.

[2] Further, claim 7 is objected to because of the following informalities: attempting to further define the structure of edible items such as kiwi fruitsfruits and vegetables by claiming that said items possess "similar sturdy yet pierce-able skins" falls outside the scope of proper definiteness in the instant claim. Consider removing the term "similar sturdy yet pierce-able skins" from the claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

[3] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[4] Claims 1-2, 4-10, and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Westmoland US-5,201,578, in view of Johnson, US-6,619,816, and in further view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, Westmoland teaches of lighted jewelry (Fig. 8) comprising:

- a. at least one earring clip (10 in view of col. 2, line 10, "For example, an ear clasp may be connected to the article of jewelry allowing it to be worn as an earring for pierced or non-pierced ears," as well as from col. 4 lines 15-20) with back side and front side for engaging a non-pierced ear;
- b. at least one hook (10b) secured to said earring clip (10);
- c. at least one decorative item removably secured to said hook (10b; col. 7 beginning with line 4, "Attachable to either the split rings via 4b, or loop 31, may be decorative elements,

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29, in this case fine chains...,” further, “Alternatively, charms, small crystals, reflectors or other such elements having interesting or pleasing visual effects may be so attached”),

d. an automatic LED disposed on a lower portion of the front side for lighting the decorative item (4; from col. 3, beginning with line 16, “Lighting elements 4 may be incandescent bulbs...or they may be light emitting diode, LED, devices...leads may be shortened so that the lighting elements 4 are positioned closed against the edge of the jewelry article”).

Though Westmoland teaches of attaching various decorative items including charms, small crystal, reflectors and other elements having interesting or pleasing visual effects for use in conjunction with the illumination provided by his invention; he fails to expressly state that the decorative item may include at least one edible food item removably secured to said hook, with said edible food item being selected from the group: a fruit, a vegetable, and combinations thereof. Johnson discloses an illuminated novelty confection item similar to that of Westmoland. In addition, Johnson further teaches of at least one edible food item (col. 2, lines 18-20, “...includes a light device, a light transmission element attached to the light device, and an edible confection attached...”) removably secured to said item, with said edible food item (12 of Johnson) being selected from the group of a fruit, vegetable, and/or combinations thereof (col. 2, lines 59-64, “The confection does not necessarily have to be limited to candies, and could include virtually anything edible...”). It would have been obvious to one of ordinary skill in the art, having the disclosures of Westmoland and Johnson before him at the time the invention was made, to modify the decorative item attached to the illuminated nonpiercing earring of Westmoland to include at least one edible food item as in Johnson. One would have been motivated to make such a combination because having edible items secured onto an item thereby

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creating a illuminated novelty confection enhances further the amusement (illuminating the confection) and commercial viability of such products (col. 2, lines 2-3); and from col. 3, lines 3-13, "From a usage or demographic perspective, there are several possibilities including children candies, specialty concession, novelties, premium, advertising and contest marketing..." as taught by Johnson.

Re: Claim 2, Westmoland discloses wherein at least one hook (10b) comprises at least two hooks (1<sup>st</sup>, 2<sup>nd</sup>, and 3<sup>rd</sup> 10b of Fig. 8) connected in series.

Re: Claim 4, Westmoland discloses wherein said LED light is a blinking LED light that can be actuated with a switch secured to said earring clip (Col. 4, 58-66; col. 5, lines 15-58, specifically, "The microchip may be designed to provide a controlled pattern of flashing to the lighting elements..." and further, "To effect such control the microchip element is attachable to either plate...as to be included in the circuit...and lastly, "apertures 24 are located and sized to accept contact pins 22 extending from microchip element 17 to provide electrical contact between microchip 19 and lighting element leads 5." Further, it has been held that broadly providing a mechanical or automatic means (switch) to replace manual activity (inserting the contact pins or inserting the battery for light activation), which has accomplished the same result, involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Re: Claim 5, Westmoland discloses wherein said hook is between 1.5 inches and 3 inches in overall length (Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189

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*USPQ 143 (CCPA 1976)* ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 *F.2d* at 1053, 189 *USPQ* at 148.). In *Gardner v. TEC Systems, Inc.*, 725 *F.2d* 1338, 220 *USPQ* 777 (*Fed. Cir.* 1984), *cert. denied*, 469 *U.S.* 830, 225 *USPQ* 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Re: Claim 6, Westmoland discloses wherein said hook (10b) is adapted to have at least a first prong and an second prong (split rings have two non-adjoining ends, which can be considered a first and second prong) for engaging at least two food items (in view of Johnson).

Re: Claim 7, Johnson discloses wherein the edible food item is selected from the group: blueberries, strawberries, dried fruits, blackberries, cherry tomatoes, kiwi fruitsfruits with similar sturdy yet pierce-able skins, and vegetables with similar sturdy yet pierce-able skins (col. 2, lines 59-64, "The confection does not necessarily have to be limited to candies, and could include virtually anything edible...").

As for Claim 8, Westmoland teaches of lighted jewelry (Fig. 8) comprising:

- a. at least one earring clip (10 in view of col. 2, line 10, "For example, an ear clasp may be connected to the article of jewelry allowing it to be worn as an earring for pierced or non-pierced ears," as well as from col. 4 lines 15-20) with back side and front side for engaging a non-pierced ear;
- b. at least one hook (10b) secured to said earring clip (10);

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c. at least one chewy candy item (in view of Johnson, see claim 1) removably secured to said hook (10b),

d. an automatic LED disposed on a lower portion of the front side for lighting the edible food item (4; from col. 3, beginning with line 16, "Lighting elements 4 may be incandescent bulbs...or they may be light emitting diode, LED, devices...leads may be shortened so that the lighting elements 4 are positioned closed against the edge of the jewelry article").

Re: Claim 9, Johnson discloses wherein said candy is selected from the group: soft licorice, soft raspberries, juicy fruits, and like soft candies ((col. 2, lines 59-64, "The confection does not necessarily have to be limited to candies, and could include virtually anything edible...").

Re: Claim 10, Westmoland discloses further comprising a line (5) wherein said hook (10b) connects said line (5) near said earring clip (10) and a second hook (1<sup>st</sup> segment of 29) connects to said line (5) further from said earring clip (10) than said hook (10b).

Re: Claim 12, Westmoland discloses wherein said LED light is a blinking LED light that can be actuated with a switch secured to said earring clip (Col. 4, 58-66; col. 5, lines 15-58, specifically, "The microchip may be designed to provide a controlled pattern of flashing to the lighting elements..." and further, "To effect such control the microchip element is attachable to either plate...as to be included in the circuit...and lastly, "apertures 24 are located and sized to accept contact pins 22 extending from microchip element 17 to provide electrical contact between microchip 19 and lighting element leads 5." Further, it has been held that broadly providing a mechanical or automatic means (switch) to replace manual activity (inserting the



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contact pins or inserting the battery for light activation), which has accomplished the same result, involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Re: Claim 13, Westmoland discloses wherein said hook is between 1.5 inches and 3 inches in overall length (Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Re: Claim 14, Westmoland discloses wherein said hook (10b) is adapted to have at least a first prong and an second prong (split rings have two non-adjoining ends, which can be considered a first and second prong) for engaging at least two food items (in view of Johnson).

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***Response to Arguments***

[5] Applicant's appeal brief, see remarks filed 11/30/2006, with respect to the rejection(s) of claim(s) under Westmoland in view of case law, have been fully considered. Therefore, the rejection with regard to Westmoland, solely, has been withdrawn. However, upon further consideration of the amended claims, a new ground(s) of rejection is made in view of Westmoland US-5,201,578, in view of Johnson, US-6,619,816, and in further view of case law. Consequently, all arguments are considered moot to said new grounds of rejection. Please note the additional notice of reference cited.

***Conclusion***

[6] **THIS ACTION IS NON-FINAL**


[7] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Reese  
Assistant Examiner  
Art Unit 3677

DCR

  
3/7/07

  
**ROBERT J. SANDY**  
**PRIMARY EXAMINER**